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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/040,103 03/17/98 MASON

J 52494-21

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HM22/0621

EXAMINER

NGUYEN, D

ART UNIT

PAPER NUMBER

1633

DATE MAILED: 06/21/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/040,103

Applicant(s)

Mason

Examiner

Dave Nguyen

Group Art Unit

1633



☒ Responsive to communication(s) filed on Jun 3, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-41 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-41 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-21, 36-38, and 41, drawn to a method of preparing human serum-resistant retroviral particles, retroviral producer cells, human serum-resistant retroviral particles produced by the preparation methods, and a method for delivering a heterologous gene to a cell by using a retroviral producer cell containing the human serum-resistant retroviral particles, classified in class 435, subclasses 455, 320.1, 325, and class 424, subclass 93.21, respectively.
- II. Claims 22-35, 39, and 40, drawn to a method of transducing a cell with human serum-resistant retroviral particles, and *in vivo* gene therapy processes using human serum-resistant retroviral particles in any subject, classified in class 424, subclass 93.2.

The inventions are distinct, each from the other because of the following reasons: Invention I and Invention II are related as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the retroviral particles of Invention I are not limited in the processes cited in inventions II and can be used in methods using a retroviral producer cells containing the retroviral particles for delivering a heterologous gene to a cell *in vivo*.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their divergent subject matter, fall into different statutory classes of invention, and are separately classified and searched, restriction for examination purposes as indicated is proper.

During a telephonic conversation with Attorney Lisa Wilson on June 10, 1999, a written restriction

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letter was requested.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Dave Nguyen* whose telephone number is (703) 305-2024.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Brian Stanton*, may be reached at (703) 308-2801.

Any inquiry of a general nature or relating to the status of this application should be directed to the *Group receptionist* whose telephone number is (703) 308-0196.

Dave Nguyen



BRUCE R. CAMPPELL
PRIMARY EXAMINER
GROUP 1800